

App. No. 09/575,516
Amendment Dated February 20, 2004
Reply to Office Action of October 27, 2003

REMARKS/ARGUMENTS

According to the Office Action mailed October 27, 2003, claims 1-22 are rejected.

Claims 1-5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (US Patent Number 5,040,142, issued on August 13, 1991) in view of Weingarten (teach yourself . . . Word Perfect 6.1 for Windows, published in 1995). Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (US Patent Number 5,040,142, issued on August 13, 1991) in view of Weingarten (teach yourself . . . Word Perfect 6.1 for Windows, published in 1995) as applied to claim 1, and further in view of Netscape Communications Corporation (Netscape Navigator Gold, Version 3.01 Gold). Claims 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (US Patent Number 5,040,142, issued on August 13, 1991) in view of Novell ("Press Release" published in 1997). Claims 11-17 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (US Patent Number 5,040,142, issued on August 13, 1991) in view of Novell ("Press Release" published in 1997) as applied to claims 10 and 18, and further in view of Weingarten (teach yourself . . . Word Perfect 6.1 for Windows, published in 1995). Claims 1-22 remain pending. Applicants respectfully request reconsideration and allowance of all pending claims.

I. Rejection of claims 1-5 and 9 under 35 U.S.C. 103(a)

Claims 1-5 and 9 are rejected in the Office Action under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (US Patent Number 5,040,142, issued on August 13, 1991) in view of Weingarten (teach yourself . . . Word Perfect 6.1 for Windows, published in 1995).

Applicants respectfully disagree as explained below.

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With regard to claim 1, claim recites "receiving from the author's computer a copy of the electronic document having a first property identifying the location of the electronic document in the memory of the author's computer". The Office Action states that "Along with the document a record is sent which includes the address of the sending station (where the document was created) and the document record (location of the document) (column 6, line 63-column 7, line 7 of Mori et al.)." This statement in the Office Action is incorrect. Column 7, line 7 of Mori et al. actually recites the presence of a pointer to a "document management data record 50".

Examining the "document management data record" of Mori et al. further, shows that this record does not include a location of the document as indicated in the Office Action. FIG. 8A of Mori et al. shows the record format for the document management data 50. Nowhere in this record format is the location of the document on the author's computer shown. The deficiency of Mori et al. to teach or suggest including within the electronic document the location of the electronic document in the memory of the author's computer is not satisfied by Weingarten. Weingarten mentions nothing of storing properties within documents. Since neither Mori et al. nor Weingarten teach or suggest this limitation of claim 1, claim 1 is patentable over Mori et al. in view of Weingarten.

In addition, claim 1 recites "said edited electronic document having said first property". The first property still identifies the location of the electronic document in the memory of the author's computer. As stated above, neither Mori et al. nor Weingarten teach or suggest the limitation of the electronic document having a first property identifying the location of the electronic document in the memory of the author's computer. This is true for both the original document and the edited electronic document. Since neither Mori et al. nor Weingarten teach or

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suggest this additional limitation of claim 1, claim 1 is patentable over Mori et al. in view of Weingarten.

Furthermore, claim 1 recites "in response to detecting the first property with the application program, displaying on the display device a review toolbar comprising selectable control elements corresponding to document review operations". The Office Action admits that Mori et al. does not teach or suggest this limitation and attempts to satisfy it by proffering Weingarten. Weingarten merely discloses a standard tool bar (referred to as the power bar) for general manipulation of a document. Weingarten states that "when you install WordPerfect, the Power Bar is displayed by default." (Weingarten, page 44, paragraph 4, lines 2-3) In contrast, claim 1 states that the review toolbar is displayed "in response to detecting the first property with the application program." The concepts for display of the Power Bar in Weingarten and display of the review toolbar of the claimed invention are therefore vastly different. Weingarten cannot be deemed to teach or suggest the limitation of displaying a toolbar when a property within a document is detected. Weingarten flatly states that the Power Bar is displayed by "default". Accordingly, since it is admitted that Mori et al. does not teach or suggest this limitation, and it is shown that Weingarten also does not teach or suggest this limitation, claim 1 is patentable over Mori et al. in view of Weingarten.

Claims 2-5 and 9 are dependent upon claim 1. Therefore, claims 2-5 and 9 are also patentable over Mori et al. in view of Weingarten for at least the reasons stated above.

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II. Rejection of claims 6-8 under 35 U.S.C. 103(a)

Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (US Patent Number 5,040,142, issued on August 13, 1991) in view of Weingarten (teach yourself . . . Word Perfect 6.1 for Windows, published in 1995) as applied to claim 1, and further in view of Netscape Communications Corporation (Netscape Navigator Gold, Version 3.01 Gold) (hereinafter "Netscape"). However, the discussion also includes arguments regarding claims 4 and 5. It may have been the intention to reject claims 4-8 on these grounds rather than 6-8. In either case, Applicants respectfully disagree as explained below.

Applicants respectfully direct attention to the discussion above with regard to claim 1. The addition of the Netscape reference to the Mori et al. and Weingarten references does not change the analysis with regard to the limitations of claim 1. Mori et al. in view of Weingarten and further in view of Netscape do not teach or suggest all of the limitations of claim 1. Claims 4-8 are dependent upon claim 1, therefore claims 4-8 are patentable over Mori et al. in view of Weingarten and further in view of Netscape for at least the reasons stated above.

III. Rejection of claims 10 and 18 under 35 U.S.C. 103(a)

Claims 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (US Patent Number 5,040,142, issued on August 13, 1991) in view of Novell ("Press Release" published in 1997). Applicants respectfully disagree as explained below.

Claim 10 recites, "sending to a reviewer a copy of the electronic document, said copy having a first property identifying the location of the electronic document in the memory", and claim 18 recites, "said edited electronic document having a first property identifying the location

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of the electronic document in the memory and indicating that review had been requested". As previously stated with regard to claim 1, Mori et al. does not include the limitation of a document, copy, edited version, or otherwise, "having a first property identifying the location of the electronic document in the memory." Examining the Novell reference, Novell also does not teach or suggest this limitation. Accordingly, since neither Mori et al. nor Novell teach or suggest this limitation, claims 10 and 18 are patentable over Mori et al. in view of Novell.

In addition, claims 10 and 18 recite, "automatically merging the edited electronic document into the electronic document." The Office action admits that Mori et al. does not teach or suggest this limitation. However, the Office Action states that Novell does disclose this limitation through its method whereby "any changes made to a document copy on an intranet are reflected on the original copy." There seems to be confusion over what merging two documents actually involves. Merging two documents involves comparing two documents to discover the changes, and possibly implement those changes into the original document. Such a method would be completely impractical over the network of described in Novell. If a document merge were used in the Novell setting, it would involve transmitting the entire document to the location of the other document and updating the document after a comparison between the documents is made. The bandwidth requirements for such an operation would be huge, and don't make economic sense. Instead, most likely, the method of Novell transmits only the changes of one document to the other document so that those changes may be incorporated. This is not a merge of one document into another, but rather merely an update, where changes in one document are reflected in the other. Accordingly, Novell does not teach or suggest automatically merging documents. Since automatically merging the edited electronic document into the electronic

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document is not taught or suggested by Mori et al. or Novell, claims 10 and 18 are patentable over Mori et al. in view of Novell.

IV. Rejection of claims 11-17 and 19-22 under 35 U.S.C. 103(a)

Claims 11-17 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al. (US Patent Number 5,040,142, issued on August 13, 1991) in view of Novell ("Press Release" published in 1997) as applied to claims 10 and 18, and further in view of Weingarten (teach yourself . . . Word Perfect 6.1 for Windows, published in 1995). Applicants respectfully disagree as explained below.

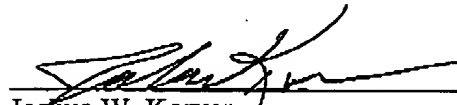
Applicants respectfully direct attention to the discussion above with regard to claims 10 and 18. The addition of the Weingarten reference to the Mori et al. and Novell references does not change the analysis with regard to the limitations of claim 10 or 18. Mori et al. in view of Novell and further in view of Weingarten do not teach or suggest all of the limitations of claim 10 and 18. Claims 11-17 and 19-22 are dependent upon claims 10 and 18 respectively, therefore claims 11-17 and 19-22 are patentable over Mori et al. in view of Novell and further in view of Weingarten for at least the reasons stated above.

In view of the foregoing amendments and remarks, all pending claims are believed to be allowable and the application is in condition for allowance. Therefore, a Notice of Allowance is respectfully requested. Should the Examiner have any further issues regarding this application, the Examiner is requested to contact the undersigned attorney for the applicant at the telephone number provided below.

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Respectfully submitted,

MERCHANT & GOULD P.C.



Joshua W. Korver

Registration No. 91,894

Direct Dial: 206.342.6257

MERCHANT & GOULD P.C.
P. O. Box 2903
Minneapolis, Minnesota 55402-0903
206.342.6200